

### **REMARKS**

These remarks are offered response to the Office Action mailed on October 5, 2006. Claims 1-10, 13-15, and 33-34, not amended herein, are now pending in this application.

Although applicant addresses the rejections as follows, it also reserves all applicable rights not exercised in connection with this response, including, for example, the right to swear behind one or more of the cited references, the right to rebut any tacit or explicit characterization of the references, and the right to rebut any asserted motivation for combination. Applicant makes no admission regarding the prior art status of the cited references, regarding them as being only of record.

### **Information Disclosure Statement**

The Final Office Action stated that the Examiner could not locate a copy of the Hunter reference that was submitted with the IDS filed on December 11, 2001. Per the request in the Final Office Action, Applicant is resubmitting a copy of the Hunter reference along with this response. Applicant respectfully requests that initialed copies of the applicable 1449 Forms be returned to its representatives to indicate consideration of the Hunter reference.

### **Background**

U.S. Patent No. 6,519,617 to Wanderski et al. (Wanderski) relates to the transformation of an XML (eXtensible Markup Language) document into a new XML dialect so that desired document transformations, such as a current user's context, are implemented in the new XML dialect. (Col. 4, lines 26-30). Wanderski further relates to the dynamic generation of a DTD (document type definition) to describe the newly created XML dialect so that the newly created XML dialect document can be processed by an XML parser in the manner dictated by the particular context of the user. (Col. 4, lines 18-24, 35-39). The user context may relate to a preference of the user, a network connection of the user, a device type of the user, and/or a browser type of the user. As used in Wanderski, the XML dialect refers to the modified tags of

the input XML document that indicate the desired transformations of the document. (Col. 7, lines 60-64).

§102 Rejection of the Claims

Claim 34 was rejected under 35 U.S.C. § 102(e) for anticipation by Wanderski (U.S. Patent No. 6,519,617). Applicant respectfully traverses this rejection.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (*emphasis added*). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

Claim 34 recites a computer-implemented method of receiving a first document for disambiguation, wherein this first document includes a first and second portion. Each portion of this document is ambiguated. The first portion of the document is disambiguated, but the second portion of the document is not disambiguated. A second document is output; the second document includes the disambiguated portion of the first document and the second portion of the first document.

The Final Office Action cites column 4, lines 25-42 and Col. 11, lines 60-67 of Wanderski in its rejection of claim 34 under 102(e). However, column 4, lines 25-42 relate only to the transformation of an XML document into a new XML dialect, and column 11, lines 60-67 relate only to a DTD that corresponds to modified tags in a Document Object Model (DOM) tree. Wanderski does not disclose that only a portion of the XML document is transformed into the new XML dialect, and that the XML dialect document includes a disambiguated first portion and a second portion of the document that is not disambiguated. That is, Wanderski does not disclose at least partial disambiguation.

Consequently, the cited portions of Wanderski do not disclose each and every element of claim 34. Applicant respectfully submits that the rejection of claim 34 is in error, that the rejection should be withdrawn, and further respectfully requests the allowance of claim 34.

§103 Rejection of the Claims

Claims 1-10 and 13-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wanderski (U.S. Patent No. 6,519,617). Applicant respectfully traverses this rejection.

The Patent Office bears the initial burden of factually supporting a *prima facie* case of obviousness.<sup>1</sup> In order for the Office Action to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.<sup>2</sup>

Claim 1 recites a computer implemented method that includes receiving a document and an associated document type definition. A map file is generated from the document. The map file includes one or more nodes, and each node represents a possible path from one node in the mapping file to another node in the mapping file. One or more candidate paths are generated. Each candidate path represents a possible path from one node in the mapping file to another node in the mapping file. A score is determined for each of the one or more candidate paths, and one of the candidate paths are selected based on the one or more scores. The selected candidate path is converted into a language described by the document type definition.

The Final Office Action admits that Wanderski does not teach the selection of a candidate path based upon the scoring of the candidate paths. The Final Office Action attempts to explain away this shortcoming by arguing that Wanderski notes redundant nodes of a DOM tree, and keeps a count of the number of times that a value occurs. The Final Office Action then goes on

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<sup>1</sup> MPEP 2142.

<sup>2</sup> MPEP § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

to state that it would have been obvious to keep a tally (score) of the nodes so as to provide a benefit of streamlining the DOM tree for a more compact document.

Applicant respectfully submits that the cited portions of Wanderski do not disclose at least “determining a score for . . . one or more candidate paths” and “selecting one of the candidate paths based on the one or more scores.” The portions of Wanderski cited by the Final Office Action relate only to the identification of multiple occurrences of a *tag* in a DOM tree, and the compacting of that *tag* information into a single declaration. (Col. 13, lines 44-53). The other portion of Wanderski cited by the Final Office Action (Col. 14, lines 4-11) relates to an attribute list, and more specifically, to the determination of which attribute value occurs most often in that attribute list, and the subsequent use of that value as a default value.

Applicant respectfully submits that there is no teaching or suggestion of determining a score of candidate paths and selecting a candidate path based on that score. The compacting of tag information into a single declaration and the determination of a default attribute value are simply not determining a score of candidate paths and selecting a candidate path based on that score. Firstly, the compacting of tag information is a simple activity of addressing data duplication. Looking for duplication in a set of nodes is much different than scoring one or more candidate paths through a set of nodes. Secondly, the jump from counting attribute values to scoring candidate paths is not forecast, projected, suggested, or in any way hinted at in Wanderski. If anything, the breadth of the leap from the simple counting of attribute values to the scoring of candidate paths evidences an act of invention. Therefore, at least because Wanderski does not disclose each and every element of claim 1, claim 1 is not unpatentable over Wanderski. *See* MPEP § 2142.

Moreover, the Final Office Action contends that it would have been obvious to a person of skill in the art to keep a tally (score) of the redundant nodes to provide the benefit of a more streamlined DOM tree and a more compact document. Notwithstanding the accuracy or inaccuracy of this contention, it has nothing to do with scoring candidate paths and selecting candidate paths based on that score. So even if the arguments and logic in the Final Office Action have some bearing on the creation of compact documents, they simply have no bearing on selecting a candidate path based on scores of one or more candidate paths.

Consequently, Applicant respectfully submits that the rejection of claim 1 is in error, and further respectfully requests the withdrawal of the rejection of claim 1. Since claims 2-8 depend on claim 1, they include at least the limitations of “determining a score of . . . one or more candidate paths” and “selecting one of the candidate paths based on the one or more scores.” For at least this reason, claims 2-8 are likewise not invalid under 103(a) in light of Wanderski.

The Final Office Action rejected independent claims 9, 13, and 14 using the same rationale as used in the rejection of claim 1. For at least the reason that Wanderski does not disclose, teach, or suggest scoring candidate paths and selecting a candidate path based on that scoring, claims 9, 13, and 14, and any of the claims dependent on these independent claims, are not unpatentable over Wanderski.

Moreover, with respect to claims 9 and 10, Applicant respectfully submits that the Final Office Action fails to put forth a *prima facie* case of obviousness. For instance, the Final Office Action does not explain where in Wanderski one of skill would find a teaching to “generat[e] a mapping file from [a] document and [a] document type definition, with the mapping file comprising one or more nodes, each node representative of a possible mapping of an element of the document type definition to a portion of the document.” Accordingly, for at least this additional reason, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 9 and 10.

Claim 33 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wanderski in view of Yamakawa et al. (U.S. Patent No. 5,907,851.) Applicant respectfully traverses this rejection.

In the rejection of claim 33, the Final Office Action specifically conceded that Wanderski omits a teaching of “providing a set of two or more DTDs, and selecting one for conversion,” but asserted that Yamakawa “teaches document conversion utilizing preparation of a plurality of ... DTDs for switching and development of one or more DTDs.” (Yamakawa, column 22, lines 22-32, Figure 67). Further, the Final Office Action contended that it would have been obvious to apply Yamakawa to Wanderski to provide “the benefit of predetermined DTD selection for eventual adherence to various established standards.”

Applicant respectfully submits that the proposed motivation is not applicable to Wanderski. Wanderski reports “a method, system, and computer-readable code for ... creating

an Extensible Markup Language, or XML dialect ... and then dynamically generating a document type definition for this XML dialect.” (Column 1, lines 16-23). As such, it appears that one of skill would view the provision and selection of a DTD from multiple DTDs to be contrary to the teachings of Wanderski. Wanderski reports dynamic generation of customized DTDs. Having a customized or tailored DTD would seem to be preferably to selecting one from a set of ready made DTDs, in the same way that having a custom tailored suit would be preferable to one off the rack. Consequently, Wanderski and Yamakawa are not properly combinable.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the §103 rejection of claim 33.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 349-9593 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

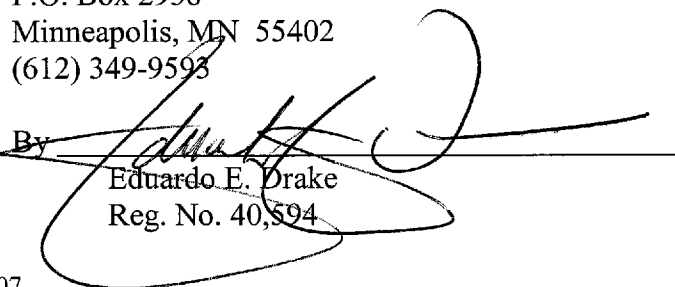
Respectfully submitted,

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This paper or fee is being filed on the date indicated above using the USPTO's electronic filing system EFS-Web, and is addressed to: The Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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